

Amendment Under 37 C.F.R. 1.111  
U.S. Application No.: 09/648,537  
Attorney Docket No.: Q59776

### **REMARKS**

Claims 1-40 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1-2, 9 and 14. The amendments to claims 1, 2, 9 and 14 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1-2, 9 and 14 were not made for reasons of patentability.

In addition, by this Amendment, Applicant adds claims 34-40. New claims 34-40 are clearly supported throughout the specification, see e.g. pages 10-15 of the Specification. No new matter is being added.

### **Summary of the Office Action**

The Examiner rejected claims 2, 6, 16 and 23 under 35 U.S.C. § 112, second paragraph, claims 1-4, 6-24 and 26-32 under 35 U.S.C. § 102(b) and claims 5, 25 and 33 under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections in view of the comments which follow.

### **Rejections under 35 U.S.C. § 112, second paragraph**

The Examiner rejected claims 2, 6, 16 and 23 under section 112, second paragraph. Applicant respectfully thanks the Examiner for pointing out, with particularity, the aspects of the claim thought to be indefinite. With respect to claim 2, Applicant respectfully requests the Examiner to withdraw this rejection in view of the self-explanatory claim amendment being made herein.

With respect to claims 6, 16 and 23, the Examiner asserts that the recitation of non-enablement for message origination (MO) is unclear because it appears to be contrary to the base claim (see page 2 of the Office Action). Applicant respectfully disagrees. Base claim 1 recites transmitting a predefined message initiation code. However, it does not limit the transmission to only MO enabled systems. Claim 1 does not specify how the transmission is made, and therefore is not inconsistent.

For example, in the background of the invention, Applicant discloses four types of wireless communication networks. The first type is mobile terminated (MT) messaging, which is a system capable of only receiving messages, but not sending messages. The second type is mobile originated (MO) messaging, which is an SMS, two-way messaging system. The third type is a wireless enabled network (WAP enabled) which provides web capabilities to the mobile station by initializing a separate session to view WML pages. This type of network can be MO enabled or only MT enabled (see pages 5-8 of the Specification).

Each type of network has its own problems. For example, WAP-enabled mobile cannot receive or initiate voice calls or messages while in WAP session. In order to initiate a voice call or SMS message, the user has to end or interrupt the WAP session or at the very least, the user cannot view the message until the session is suspended (see page 8, line 15 to page 9, line 22 of the Specification). Similarly, MT network has its own problems. For example, it can only send a predefined message by selecting from a global predefined messages via I-VRU (interactive-voice response unit), see e.g., page 10, lines 6 to 22 of the Specification.

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An illustrative, non-limiting embodiment of the present invention, discloses a wireless initiated messaging system, which can provide personalized messaging (e.g. WIM messages) for all these different systems. In particular, a WIM session can be initiated at any time, including while the mobile station is in WAP session (e.g, pages 24-25 of the Specification), by simply entering a short code (e.g. Figs. 3A-3B; pages 19-21 of the Specification).

With respect to the independent claim 1, it only recites transmitting an initiation code. There is no recitation as to the type of network in claim 1. Therefore, Applicant respectfully submits that claim 6 further defines the network by specifying that the network is not MO-enabled. As a result, Applicant respectfully requests the Examiner to reconsider and to withdraw this rejection of claim 6.

Claims 16 and 23 are not contradictory to their respective base claims 14 and 19 for at least similar reasons, namely the base claims do not comprise a limitation as to the type of network. As a result, reciting a particular network type in the dependent claims 16 and 23 does not contradict independent claims 14 and 19, respectively, which are silent on the type of network. In short, Applicant respectfully requests the Examiner to reconsider and to withdraw these rejections of claims 16 and 23.

#### **Rejections under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-4, 6-24 and 26-32 under 35 U.S.C. § 102(b) as being anticipated by USP 6,560,456 to Lohtia et al. (hereinafter "Lohtia"). Applicant respectfully

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traverses this rejection and respectfully requests the Examiner to reconsider this rejection in view of the comments, which follow.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicants’ claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention. Of all the rejected claims, only claims 1, 9, 14, 19 and 26 are independent.

Claim 1 recites a number of novel features not taught by the prior art. For example, claim 1 recites:

...a predefined message initiation code  
initiating a messaging session, a message  
identifier identifying a predefined,  
personalized message...

The Examiner asserts that claim 1 is directed to a method of sending a message in a wireless network and is anticipated by Lohtia. The Examiner asserts that Lohtia’s digit trigger and the pre-selected service feature code trigger are equivalent to an initiation code and a message identifier, respectively, as set forth in claim 1 (see page 3 of the Office Action). Applicant respectfully disagrees with the Examiner. Applicant has carefully studied Lohtia’s discussion of the triggers, which are not similar to an initiation code and a message identifier as set forth in claim 1.

Lohtia teaches a method and a system for providing information to a communication device in response to a request for such service received from the communication device. The request may be in the form of a digits request trigger or SMS origination message that is initiated from a wireless telephone. The requested information is retrieved from the web via SMS message or a microbrowser message and this information may be formatted according to a pre-selected configuration that is stored in a user service information profile (see *Abstract*).

However, Lohtia teaches that the trigger may be any telephone number digits and that alternatively the trigger may be a pre-selected service feature code (col. 1, lines 49 to 51, line 57; col. 6, lines 10 to 16, lines 36 to 39, lines 54 to 56). That is, Lohtia teaches that the trigger (the code to initiate the request) may be a numeric code or a feature code. But it fails to teach or suggest transmitting an initiation code and a message identifier.

In fact, in Lohtia, there is no need to transmit both, because this numeric code or a feature code requests only one type of service based on the pre-selection of the user (e.g. #87 to designate "800-WEATHER"). Lohtia fails to teach or suggest a system where a number and a feature code would be necessary (e.g., dialing the weather but based on the feature code providing temperature only or weekly forecast, etc.). In short, Lohtia fails to teach or suggest transmitting an initiation code and a message identifier.

Therefore, *a predefined initiation code and a message identifier* as set forth in claim 1 is not suggested or taught by Lohtia, which only teaches a trigger such as a numeric code or a feature code. For at least these reasons, Applicant respectfully submits that independent claim 1

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is patentably distinguishable (and is not obvious) from Lohtia. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 1. Also, Applicant respectfully submits that claims 4-8 are allowable at least by virtue of their dependency on claim 1. In addition, with respect to claim 6, Applicant respectfully points out that Lohtia only teaches sending SMS or microbrowser messages. Lohtia teaches that subscribers communicate with system 10 via handset 11, which is capable of sending, receiving and displaying SMS or micro-browser messages or text messaging (col. 4, lines 53 to 61). Lohtia's system is not operable with a non-MO messaging type of network (e.g. MT messaging type of network). Therefore, claim 6 is patentable for at least this additional reason.

Next, Applicant respectfully traverses this rejection with respect to claims 9-13. Of these claims only claim 9 is independent. Claim 9 recites a number of novel features including, for example,

...a signal comprising a predefined message initiation code initiating a wireless messaging session, and a message identifier identifying a predefined, personalized message, wherein the predefined, personalized message is defined by or on behalf of the subscriber;

This recitation is similar to the recitation of predefined message initiation code and a message identifier recited in claim 1. Since claim 9 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. In addition, claim 9 recites retrieving the predefined message identified by the

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message identifier, whereas Lohtia clearly teaches that a message is provided by use of a “trigger” (initiation action). For at least these reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 9 and its dependent claims 10-13.

Next, Applicant respectfully traverses the rejection with respect to claims 14-18. Of these claims, only claim 14 is independent. Claim 14 recites a number of novel features including a predefined message initiation code and a message identifier similar to the ones recited in claim 1. Since claim 14 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the same reasons, therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 14 and its dependent claims 15-18.

Next, Applicant respectfully traverses this rejection with respect to claims 19-24. Of these claims, only claim 19 is independent. Claim 19 recites a number of novel features, including for example “a predetermined short code...the message number...displays the received messages on the display as selectable messages”. Recitation of a predetermined short code and a message number as set forth in claim 1 is somewhat similar to the recitation of the initiation code and a message identifier as set forth in claim 1. Since claim 19 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here.

Moreover, claim 19 recites displaying the received messages on the display as selectable messages. The Examiner failed to particularly point out, which teachings of Lohtia correspond to this recitation of claim 19. In fact, Lohtia fails to teach or suggest such recitation. A numeric or special feature code identifies the message (as explained above, see argument with respect to claim 1); therefore, in Lohtia only one message at a time (the requested service) is received by the user. Moreover, there is no selection of the received messages in Lohtia. User pre-selects in advance the information, he or she wants to receive; in Lohtia, there is no way to select messages once a request is sent to the center. In short, Lohtia does not teach or suggest displaying received messages on a display as selectable messages. For at least these reasons, therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 19 and its dependent claims 20-24.

Finally, Applicant respectfully traverses this rejection with respect to claims 26-32. Of these claims, only claim 26 is independent. Independent claim 26 recites a number of novel features, including for example, originating a short message...while the mobile station maintains an active session with an information session. The Examiner did not particularly point out, how this recitation is met by Lohtia (see page 3 of the Office Action).

As explained in the background section of the invention, WAP session, for example, occupies the link and short messages cannot be received while in WAP session or for that matter any other session is active with an informational server (e.g., see page 8 of the Specification). Lohtia is no different from the prior art and suffers the same problem. Therefore, a micro-



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browser message is initiated while the mobile station is in active session, short messaging is initiated only in SMS mode (see e.g. Title; col. 10, lines 11 to 19). Lohtia does not teach or suggest originating a short message while in active session; if the originating device in Lohtia is in active session, a micro-browser message is initiated not a short message.

In short, *originating a short message while the mobile station maintains active session with an information server* as set forth in claim 26 is not suggested or taught by Lohtia, which only teaches sending a micro-browser message in active session. For at least these reasons, Applicant respectfully submits that independent claim 26 is patentably distinguishable (and is not obvious) from Lohtia. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 26. Also, Applicant respectfully submits that claims 27-32 are allowable at least by virtue of their dependency on claim 26.

#### **Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 5, 25 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Lohtia. Applicant has already demonstrated that Lohtia does not render obvious independent claims 1, 19 and 26. Therefore, claims 5, 25 and 33 are patentable at least by virtue of their dependency on claims 1, 19 and 26, respectively. In addition, Applicant respectfully submits that claims 5 and 25 are patentable for at least the following additional reasons.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rikckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, **the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular.** *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also*, *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

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The Examiner acknowledges that Lohtia fails to specifically teach the identifier of the receiving station being a distribution list identifier but the Examiner asserts that it would have been obvious to designate an identifier for a group list to distribute the same information to a group recipients (see page 5 of the Office Action). Applicant respectfully disagree with the Examiner.

Lohtia teaches, in an alternative embodiment, providing an enhanced advertising services to the users (col. 10, lines 25 to 60). However, instead of sending to this number of users the actual retrieved information, Lohtia teaches sending a trigger (numeric or feature code to the user). Thereby, the user will be sent to the server to retrieve this information. In short, Lohtia teaches away from sending the actual information to a number of subscribers, instead only the trigger is sent.

In addition, Applicant respectfully points out that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination” In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) (citing ACS Hosp. Sys. v. Montefiore Hosp., 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Winner International Royalty Corporation v. Ching-Rong Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). Conclusory statements such as common knowledge to one skilled in the art or common sense do not fulfill the agency’s

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obligation. In re Sang Su Lee, 277 F.3d 1338, 1345 - 46, 61 U.S.P.Q.2d 1430, 1438 (Fed. Cir. 2002).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is *casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.* See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Hindsight has repeatedly been held to be improper and ineffective in supporting an argument of *prima facie* obviousness. See, e.g., *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Bond*, 15 USPQ2d 1556 (Fed. Cir. 1990); *In re Laskowski* 10 USPQ2d 1397 (Fed. Cir. 1989). On the present record, the references simply do not provide the impetus to do what the inventor did. Lohtia teaches that the identification of the calling party is MIN or the Calling Party Number. There is no suggestion that instead of MIN or a number, the receiving device identifier can be a distribution list.

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In short, Applicant respectfully submits that Lohtia fails to teach or suggest a receiver device identifier identifying a distribution list as set forth in the dependent claims 5 and 25. Lohtia does not render this feature obvious. For at least these additional reasons, Applicant respectfully submits that claims 5 and 25 are patentable.

#### **New Claims**

In order to provide more varied protection, Applicant adds claims 34-40. Claim 34 is patentable over Lohtia at least by virtue of its recitation of designing a personal, short communication message by a subscriber and storing said message in a database. In Lohtia, the information (the actual message) is retrieved from the web and only the presentation of this information is user specific. In short, Lohtia does not teach or suggest designing a personal message. In addition, in Lohtia, since the information constantly changes, the actual message is not stored in the database. In Lohtia only the user preferences are stored in a database. Clearly, claim 34 is patentable over Lohtia.

In addition, claims 35-40 are patentable at least by virtue of their dependency.

#### **Conclusion and request for telephone interview**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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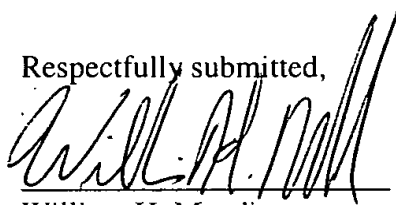
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**23373**

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William H. Mandir', written over a horizontal line.

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Date: February 25, 2004